REMARKS

Prior to entry of this Amendment:

- Claims **1-54 and 57-74** were pending in the present application
- Claims **1-54 and 57-74** stand rejected

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims **75-108** will be pending
- Claims 1-54 and 57-74 will be canceled
- Claims **75-108** will be added
- Claims **75, 107 and 108** will be the only independent claims

A. Claims 1-54 and 57-74 have been cancelled

Claims 1-54 and 57-74 have been canceled without prejudice. We submit that Claims 1-54 and 57-74 contain allowable subject matter, and that Claims 1-54 and 57-74 have been canceled solely in order to expedite prosecution of the present application. We intend to pursue the subject matter of the canceled claims in a continuing application.

B. Section 101 Rejection

Claim 67 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. [Office Action, page 2]. Claim 67 produces a useful, concrete and tangible result. We disagree that a claim must "necessarily require or set forth a computer." However, Claim 67 has been canceled; the Section 101 rejection is moot.

C. Section 102(e) and Section 103(a) Rejections

All of the rejected Claims 1-54 and 57-74 have been canceled without prejudice. We do not agree with any of the Examiner's rejections in light of the cited references. However, the rejections are moot. Some assertions made by the Examiner with respect to the canceled claims are discussed below.

D. New Claims 75-108 Contain Allowable Subject Matter

New Claims **75-108** are allowable over the cited references.

1. Independent Claims 75, 107 and 108

We respectfully submit that Claims **75, 107 and 108** are not obvious in light of any combination of the cited references (Kolls, Jennings, and Paige).

75. (NEW) A method comprising:

determining a gambling history of a player;

selecting the player to receive a survey question based on the gambling history;

transmitting the survey question to the player via a slot machine;

receiving a response of the player to the survey question;

determining compensation for the response; and

after receiving the response, transmitting a signal to the slot machine to provide the determined compensation to the player.

No combination of the cited references suggests *selecting a player to receive a survey question based on a gambling history of the player*, as generally recited in new Claim **75**.

The Examiner asserts: "It would have been obvious to one of ordinary skill at the time of the invention to have used any type of customer profile information in order to associate the response data with the customer profiles." [page 8]. We do not agree. The Examiner has not provided any evidence in support of this assertion. That Kolls describes some types of information related to a customer does not necessarily suggest "any type of customer profile information" (emphasis added). In fact, Kolls is devoid of any hint as to how it selects a customer to receive a survey question.

In fact, the Examiner concedes, "Kolls does not teach gambling history" (emphasis added). None of the other references hints at the desirability of using gambling history as the basis for selecting a player for anything, much less for receiving a survey question. The Examiner does not assert otherwise. Thus, there is no substantial evidence of record that it would have been obvious to *select a player to receive a survey question based on a gambling history of the player.*

No combination of the cited references suggests *transmitting the survey question to the player via a slot machine*, or *after receiving the response to the survey question, transmitting a signal to the slot machine to provide the determined compensation to the player*, as generally recited in new Claim **75**.

The Examiner asserts, with respect to Kolls:

> The user may respond to the ads and request that more information be given, a printout created, the user taken to a web site, or an audio interactive advertisement presented [35:35-45, 41:33-35]. This ability to receive user-responses from displayed ads is taken to inherently provide prompting/questioning the user if they desire more information/services regarding the targeted products. This prompting/question is taken to be a survey for feedback; the machine surveys user's for product interest/feedback. Providing such additional information is taken to be compensation for the survey response.

[pages 6-7]. As we best understand it, the Examiner is also asserting that because a user of a vending machine in the Kolls system can respond to an advertisement, the advertisement itself is a *survey question*. We do not agree with the Examiner's interpretation; there is no such suggestion that an advertisement in Kolls is a *survey question*. Further, the Examiner seems to be asserting that information provided in response to a request for more information suggests providing compensation for making the request. This interpretation is unfounded. There is no evidence in the record that giving someone what she asks for is "compensation" for the act of asking for it. We request a reference supporting such an interpretation of requesting additional information in the Kolls system.

Further, Kolls clearly distinguishes between what it calls "advertisements" and "survey questions." [See, *e.g.*, col. 47, l. 49 to col. 48, l. 36 (describing how a user responds to an "interactive advertisement" and in response, the system prompts the user to respond to a "survey question")]. The advertisements of Kolls,contrary to the Examiner's assertion, do not "inherently" disclose *a survey question*.

Kolls describes identifying a customer requesting to use a vending machine. It may be determined that a customer qualifies for "special pricing, or has earned a promotional reward." [col. 26, lines 59-67]. No discussion of how such a determination is made is provided. According to the Examiner, the "special pricing" or "a promotional reward" is "compensation" for the customer. There is no indication in Kolls, however, of what the customer is being compensated for. There is no suggestion that the pricing or reward is related to a survey. We request clarification as to why the Examiner believes "special pricing" and "promotional rewards," as described in Kolls are "compensation." Regardless, the cited portion does not suggest determining compensation for a response to a survey question, much less signaling a slot machine to provide compensation to a player for a response to a survey question.

The Examiner takes Official Notice "that it is well known to compensate users for completing surveys with such items as discounts, coupons, cash, credits,

etc." [page 7]. The Examiner does not provide substantial evidence in the record that compensating someone for completing a survey was "well known," much less compensation in the form of the specific "items" listed by the Examiner. Accordingly, the mere assertion cannot be relied upon in rejecting any claim as obvious; it is not substantial evidence. Further, the Examiner asserts that it would have been obvious to compensate survey participants "to encourage higher participation rates." The Examiner does not provide any evidence in support of this assertion. Kolls does not suggest that compensation would encourage higher participation rates. Accordingly, the mere assertion cannot be relied upon in rejecting any claim as obvious.

The Examiner asserts that it would have been obvious to combine Kolls and Jennings "to enable players/users to receive bonus compensation." Jennings teaches a vending machine with bonus dispensing means for dispensing at least one additional item "as a bonus for payment of the coin." Jennings is directed to a "bonus" for making a purchase, and has nothing to do with compensation for a response to a survey. Thus, the combination proposed by the Examiner might provide only for the ability to provide additional bonus articles when a customer makes a purchase of an article at a vending machine. Neither of the references suggests dispensing any articles as compensation for a response to a survey question. Thus, there is no motivation to combine the references to provide for "bonus" articles for responding to a survey. The Examiner also asserts that the proposed combination would improve the "attractiveness" of the Kolls system, but does not explain what "attractiveness" means (attractive in what way? to whom?) or how the references support this assertion. Accordingly, we do not agree and we request clarification as to this asserted motivation.

Although Paige describes slot machines, there is no hint in Paige of the desirability of providing a survey question to a player via a slot machine or transmitting a signal to a slot machine to compensate a player for responding to a survey.

We submit that no combination of the cited references would suggest *selecting a player to receive a survey question based on a gambling history of the player, transmitting the survey question to the player via a slot machine*, or *after receiving the response to the survey question, transmitting a signal to the slot machine to provide the determined compensation to the player*, as generally recited in new Claim **75**. Further, there is no motivation of record to combine any of the cited references in a manner that would provide for all of the features of new Claim **75**.

New Claim **107** is an independent claim directed to a computer-readable medium and recites the method of Claim **75**. New Claim **108** is an independent claim directed to an apparatus that recites the computer-readable medium of new Claim **107**. New Claims **107 and 108** are believed to be allowable for at least the same reasons as new Claim **75**.

Accordingly, we submit that all of the new independent Claims **75** (and Claims **76-106** dependent therefrom), **107 and 108** contain allowable subject matter.

2. Claims 76-78

We respectfully submit that Claims **76-78** (which depend directly or indirectly from new Claim **75**) are not obvious in light of any combination of the cited references.

> 76. (NEW) The method of claim 75, in which selecting the player comprises:
>
> determining an amount lost gambling by the player; and
>
> selecting the player based on the amount lost gambling.

There is no hint in any of the references of determining an amount lost gambling by the player, much less *selecting a player to receive a survey question based on the amount lost gambling*, as generally recited in Claim **76**. Although Paige describes "gambling information data" that is "based upon actual user gambling play," it does not suggest an amount lost gambling. Further, there is no hint in any reference of selecting a player to receive a survey question based on such an amount.

Claim **77** depends from Claim **76** and recites that *the amount lost gambling is over a plurality of gambling sessions*. None of the references suggest this feature.

Some embodiments of the present invention advantageously provide for selecting a player to receive a survey question if the player has lost a particular amount gambling. For example, a slot server can select for surveys only players that have lost a certain amount of money. Such players may be more likely to agree to complete surveys. [See, *e.g.*, Specification, page 22, ll. 4-7]. Claim 78 depends from Claim 76 and recites that selecting the player to receive the survey question is if the amount lost gambling is not less than a predetermined amount. The cited references do not suggest any such feature or hint at the desirability of such a feature.

Accordingly, we submit that new Claims **76-78** contain allowable subject matter for at least these reasons.

3. Claims 79 and 80

We respectfully submit that Claims **79 and 80** (which depend from new Claim **75**) are not obvious in light of any combination of the cited references.

In addition, Claims **79 and 80** recite in which the determined compensation comprises *offsetting* (Claim **79**) or *erasing* (Claim **80**) *a gambling loss of the player*. Some embodiments of the present invention provide for an amount of compensation dispensed to reduce or eliminate a player's gambling losses (*e.g.*, for the present gambling session, for a certain number of gambling sessions, for a certain time period, etc.). The prospect of eliminating gambling losses already incurred can motivate a player to participate in a survey. [See, *e.g.*, Specification, page 25, ll. 16-21]. There is no suggestion in the cited references that a player's compensation may include the offsetting or erasure of a gambling loss of the player.

The Examiner asserts with respect to canceled Claim 70: "the value earned as compensation to the player can be viewed as compensation for anything—including a gambling loss" and "[a]ny compensation by the machine can be taken to be 'to offset a gambling loss'...." [pages 8, 11]. We submit that no cited references even remotely hints at compensation to offset a gambling loss; there is no evidence supporting the Examiner's assertion. Regardless, as recited in new Claims **79 and 80**, the compensation includes the offsetting or erasing of a gambling loss, respectively. The Examiner also asserted: "[Claim 70] does not require the system/apparatus or method steps to determine or define any such gambling loss." [page 8]. Unless the Examiner is asserting that *gambling loss* is an indefinite term (which we dispute), this has nothing to do with the patentability of the claimed subject matter. A claim does not need to explain how a *gambling loss* may be determined; that is the role of the disclosure, not the claims.

Accordingly, we submit that new Claims **79 and 80** contain allowable subject matter for at least these reasons.

4. Claims 81-92

We respectfully submit that Claims **81-92** (which depend from new Claim **75**) are not obvious in light of any combination of the cited references.

None of the cited references teaches or suggests compensation comprises any of the following, much less as compensation for responding to a survey question:

- participation in a game of chance (Claim 81);
- participation in a game of skill (Claim 82);
- a gambling token (Claim 83);
- an increase in odds of winning in a game of chance (Claim 84);
- an increased prize table (Claim 85);
- an insurance protection against a loss (Claim 86);
- an ability to play a higher denomination currency gaming machine for a lower denomination currency (Claim 87);
- a free use of an extra slot in a multi-slot slot machine (Claim 88);
- an ability to play the slot machine for free (Claim 89);
- an ability to have winnings rounded up to a higher level (Claim 90);
- a free room (Claim 91); or
- a subsidized room (Claim 92).

Accordingly, we submit that new Claims **81-92** contain allowable subject matter for at least these reasons.

5. Claims 93-95

We respectfully submit that Claims **93-95** (which depend from new Claim **75**) are not obvious in light of any combination of the cited references.

In some embodiments of the present invention, compensation may include activating an inactive payline. In some embodiments, compensation may include retroactively activating a payline (*e.g.*, making the payline active after an outcome is generated so that the player receives the benefit of that outcome). For instance, in some embodiments, the player can obtain a prize on a payline that was inactive when the corresponding outcome (*e.g.*, a winning symbol set) was generated. [See, *e.g.*, page 25, l. 22 to page 26, l. 8]. The cited references do not teach or suggest any such features, much less in which compensation for a response to a survey comprises such features. Specifically, none of the cited references teaches or suggests in which compensation relates in any way to a payline, much less in which the determined compensation comprises any of:

- activating an inactive payline (Claim 93);
- allowing the player to receive a prize corresponding to an outcome on an inactive payline (Claim 94); or
- retroactively activating a payline in exchange for gambling plays (Claim 95).

The Examiner asserts, with respect to canceled Claim 74: "compensating a winner having a matching slot machine symbols is taken to 'retroactively activate' a payline in exchange for playing the gambling machine." [page 11]. We do not understand what the Examiner means: what exactly "is taken to 'retroactively activate' a payline"? Also, there is no evidence given in support of this assertion. We request clarification of how the asserted scenario of a "winner" with matching slot machine symbols would suggest to one of ordinary skill in the art the retroactive activating of a payline, and request a reference supporting the Examiner's assertion. Nothing in the cited references remotely suggests retroactively activating a payline, much less doing so in exchange for gambling plays.

Accordingly, we submit that new Claims **93-95** contain allowable subject matter.

6. Claim 98

We respectfully submit that Claim **98** (which depends from new Claim **75**) is not obvious in light of any combination of the cited references.

Claim **98** recites in which the determined compensation comprises *placing an advertising logo on a payline of the slot machine.* None of the references suggest such a feature. Although Paige describes providing advertising at a slot machine, it does not suggest that compensation to a player includes placing such advertising. In contrast, some embodiments of the present invention provide for compensation that involves enabling a payline that includes an advertising logo. [See, *e.g.*, Specification, page 25, ll. 22-25].

Accordingly, we submit that new Claim **98** contains allowable subject matter.

7. Claims 99-101

We respectfully submit that Claims **99-101** (which depend from new Claim **75**) are not obvious in light of any combination of the cited references.

None of the cited references teaches or suggests transmitting a survey question to a player via a slot machine at any of the following times:

- a time when the player is losing (Claim 99);
- a time when a reel of the slot machine is spinning (Claim 100); or
- a time when a coin is dropping at the slot machine (Claim 101).

The Examiner asserts, with respect to canceled Claim 68: "the machine identifying a user inserting a coin is taken to accomplish determining a time the user is losing. The user is trading the inputted money for something in return which has less value (i.e. less the profit made by the vending entity); in this manner the user is losing." [page 8]. We do not agree with this interpretation. We note that the Examiner has not cited any evidence supporting this view of transactions at a vending machine.

First, we note that the Examiner's interpretation is strained at least because he ignored the explicit limitation of a *player*. [The Examiner's interpretation of *player* as being identical to "user" is discussed further below.] When the explicit language is considered properly, a more reasonable interpretation of *a time when a player is losing* would be apparent to one having ordinary skill in the art. It is readily understood, for example, that one who plays (*e.g.*, a game) may be described as winning or losing (or in a draw, etc.).

Second, we understand that the Examiner is asserting that any vending transaction that is profitable for a "vending entity" suggests a "loss" for the buyer because the buyer is somehow "overpaying." We do not agree, and none of the references supports this analysis of vending transactions. We submit that the Examiner's rationale has confused a vending entity's cost of goods as being identical to the value of an item to a buyer. That a buyer would pay $3 to acquire a candy bar from a vending machine, from which the seller profits $1, does not mean the buyer has somehow "lost" the $1 difference between the seller's costs and the purchase price. No evidence of record supports such an interpretation. To the contrary, a more reasonable analysis of the Examiner's hypothetical is that the buyer has acquired a candy bar that the buyer valued at at least $3 at the time of purchase; we know this because the buyer paid $3.

Furthermore, Kolls suggests providing a survey question only in response to a user responding to an "interactive advertisement." [See, *e.g.*, col. 47, l. 49 to col. 48, l. 35]. Thus, Kolls is devoid of any hint of transmitting a question to a player *at a time when the player is losing*, *at a time when a reel is spinning*, or *at a time when a coin is dropping*. The Examiner appears to make a conclusory statement that all such features would have been obvious "as a matter of design choice." [See, *e.g.*, pages 10-11]. To characterize a feature as "a matter of design choice" is simply to restate a conclusion the feature is obvious; it is not substantial evidence

supporting that conclusion. None of the references remotely suggests the desirability of timing the transmission of survey questions in accordance with any such features, and the Examiner has not otherwise provided substantial evidence of record to support his conclusion.

Accordingly, we submit that new Claims **99-101** contain allowable subject matter for at least these reasons.

8. Claim 105

We respectfully submit that Claim **105** (which depends from new Claim **75**) is not obvious in light of any combination of the cited references.

None of the cited references teaches or suggests *in which the response to the survey question comprises a commitment*, as recited in new Claim **105**.

Accordingly, we submit that new Claim **105** contains allowable subject matter for at least these reasons.

For at least the reasons stated herein, we respectfully request allowance of the new Claims **75-108**.

E. Additional Comments

The Examiner asserts: "Applicant argues that a user is not a player." [page 11]. We wish to clarify: We argued that the "user" or "customer," as those terms are used in Kolls (the only cited reference at the time) and were relied upon by the Examiner, would not have suggested a "player" to one of ordinary skill in the art. We maintain this assertion. Given even its broadest reasonable interpretation, a "player" is "one who plays." The "user" of Kolls does not fairly suggest "one who plays," and the Examiner has not provided substantial evidence to the contrary. In making this clarification, we do not disclaim a "player" who reasonably might also be described as a "user." We simply reiterate that the terms are not necessarily equivalent, as relied upon by the Examiner, and maintain that the "user" of Kolls does not suggest a "player."

The Examiner also asserts: "a 'player' is taken to require nothing more than a 'user.' The adjective [sic, noun] 'player' merely describes a user...." [page 11]. The Examiner does not support this assertion of equivalence with any evidence of record. As noted above, we dispute this interpretation; given its broadest reasonable interpretation, a "player" is "one who plays." It is not clear why the

Examiner believes one having ordinary skill in the art would have ignored that a "player" is "one who plays."

The Examiner also asserts, with respect to the recited term, *player*: "Applicant should set forth positive method steps or positive system/apparatus features in order to give sufficient meaning to the term 'player.' Applicant should define features of method steps, systems and apparatuses, not people." [page 12]. We traverse any implication that "player" is without "sufficient meaning" as recited, is unclear or is otherwise indefinite under Section 112. The meaning of the term *player* would be reasonably clear to one having ordinary skill in the art and in light of the Specification; Section 112 demands no more. If the Examiner intended to make a rejection for indefiniteness, we request that the Examiner clarify the basis for rejection. Also, we note that we have not claimed "people." We have defined subject matter squarely within the statutory classes defined in Section 101 (*e.g.*, methods, apparatus). In properly defining method steps, we have recited steps involving or related to a *player*. Further, we request the Examiner provide the basis of his suggestion that we not define features of "people." We know of nothing that is *per se* nonstatutory or even inappropriate if, in defining what is clearly statutory subject matter (*e.g.*, a method), we refer to individuals generally or to those with particular characteristics (*e.g.*, a human being, a player, a human being associated with a losing gambling history).

F. Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

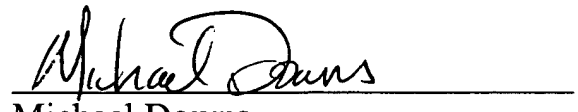
G. Petition for Extension of Time to Respond

We hereby petition for a one-month extension of time with which to respond to the Office Action. Please charge $55.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

August 12, 2004
Date



Michael Downs
Attorney for Applicants
Registration No. 50,252
mdowns@walkerdigital.com
(203) 461-7292 /voice
(203) 461-7300 /fax